

REMARKS

Claims 1, 3 and 4 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Dennison et al.

In the statement of the rejection the Examiner referred to, *inter alia*, Figs. 4 through 14 of Dennison et al., asserting the disclosure of a semiconductor device corresponding to that claimed, including an active region bounded by isolation region 110/112. The Examiner also determined that the active region is inclined downwardly toward the isolation region and that the active region is inherently rounded. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). In order to rely upon the doctrine of inherency, the Examiner must provide a **factual** basis upon which to predicate the determination that an allegedly inherent result **necessarily** flows from the teachings of the applied prior art. *Crown Operations International Ltd. v. Solutia Inc.*, *supra*; *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994); *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 20 USPQ2d 1746 (Fed. Cir. 1991). That burden has not been discharged.

Specifically, the Examiner asserted that the active region in the access transistor of the device disclosed by Dennison et al. is inherently, i.e., **necessarily**, rounded. But it is **not**. This should be apparent from the very figures relied upon by the Examiner. Applicants note that in Fig. 4 of Dennison et al., the active region 114 of the access transistor includes: (a) a central region 115 which is positioned **remote** from the bird's beak regions 118, 120; and (b) a **peripheral** region 116

outside the central region 115 of the active region 114. Since the bird's beak regions 118, 120 are positioned on the peripheral region 116, the surface of the peripheral region 116 is rounded. However, as the bird's beak regions 118, 120 **are spaced** apart from each other and are **not** positioned on the central region 115, the surface of the central region 115 in the active area 114 is not rounded. Accordingly, the Examiner's inherency determination is eviscerated by the very disclosure of Dennison et al.

Based upon the foregoing it should be apparent that Dennison et al. do not disclose or suggest, expressly or inherently, a semiconductor device as claimed comprising an access transistor having a surface **entirely rounded** and inclined downwardly toward a bordering isolation region. This structural difference between the claimed invention and the semiconductor device disclosed by Dennison et al. undermines the factual determination that Dennison et al. disclose a semiconductor device identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

Applicant, therefore, submits that the imposed rejection of claims 1, 3 and 4 under 35 U.S.C. § 102 for lack of novelty as evidenced by Dennison et al. is not factually viable and, hence, solicits withdrawal thereof.

Claims 5 and 6 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Dennison et al. in view of Ando et al.

This rejection is traversed. Specifically, claims 5 and 6 depend from independent claim 1. Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 102 for lack of novelty as evidenced by Dennison et al. The

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secondary reference to Ando et al. does not cure the argued deficiencies of Dennison et al.

Accordingly, even if the applied references are combined as suggested by the Examiner, and Applicant does not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Applicant, therefore, submits that the imposed rejection of claims 5 and 6 under 35 U.S.C. § 103 for obviousness predicated upon Dennison et al. in view of Ando et al. is not factually or legally viable and, hence, solicits withdrawal thereof.

Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP


Arthur J. Steiner

Registration No. 26,106

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 AJS:bjs:ntb
Facsimile: 202.756.8087
Date: January 6, 2005

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